

identified by the chip field; and

an equipment field containing data representing an identifier for personalization equipment used by a personalization system to program the microprocessor identified by the chip field.

43. (Unchanged) The computer-readable medium of claim 42, further comprising:
an application field containing data representing an identifier for an application to be programmed into the microprocessor identified by the chip field.

44. (Unchanged) The computer-readable medium of claim 43, further comprising:
a security field containing data representing a security function for the application identified by the application field.

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on December 18, 2002, and the references cited therewith. No claims are amended, canceled, or added; as a result, claims 25-44 remain pending in this application.

§102 Rejection of the Claims

Claims 25-44 were rejected under 35 USC § 102(e) as being anticipated by Dethloff et al. (U.S. Patent No. 4,968,873).

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*,

722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of anticipation because Dethloff does not teach each and every claim element. Dethloff describes a card issuing machine and issued cards. Dethloff's teachings are summarized in more detail in the applicant's previous Amendment and Response.

In contrast, applicant's claimed invention describes a personalization system, particular personalization equipment, and a portable programmed data carrier. Applicant's personalization system acquires personalization equipment characteristics for particular personalization equipment and transfers the data stream to the particular personalization equipment to issue the data carrier. As stated in Applicant's specification, the term "personalization equipment" encompasses various types of personalization equipment, such as:

card printers, embossing devices, and integrated or add-on smart card interface devices collectively represented in Figure 1A as personalization system 130. Personalization equipment 130 also represents such devices as large volume card printer/embossers, small volume card printer/embossers, automatic teller machines (ATMs), point of sale terminals, unattended kiosks, personal computers, network computers, and on-line telecommunication devices. Because of their investment in existing non-smart card personalization equipment, many card issuers do not purchase entirely new smart card personalization equipment but instead augment their existing personalization equipment with a smart card interface device which programs the chip in the card while the older device performs the printing and embossing functions. [Specification: page 11, lines 1-11]

Dethloff does not teach or suggest an element corresponding to applicant's personalization system. Since Dethloff has no personalization system, it does not teach or suggest a method in a personalization system comprising "acquiring *personalization equipment characteristics for particular personalization equipment*" or "translating the internal script into a data stream in accordance with the *personalization equipment characteristics*" as recited in applicant's claim 25.

Thus, Dethloff does not teach or suggest applicant's claimed invention because Dethloff does not teach a method in a personalization system that acquires "personalization equipment characteristics" or translates an internal script "in accordance with the personalization equipment characteristics."

Claim 26 further distinguishes over Dethloff. Claim 25, on which claim 26 depends, recites: "A method in a personalization system of processing data for a portable programmed data carrier comprising: ... acquiring personalization equipment characteristics for particular personalization equipment." Claim 26 recites: "transferring the data stream to the *particular personalization equipment* to issue the data carrier." Thus, Applicant's method in the personalization system acquires characteristics for particular personalization equipment and transfers the data stream to the particular personalization equipment to issue the data carrier.

Independent claims 35, 38, and 42 contain similar elements to those argued above for claims 25 and 26, and are patentable for similar reasons.

- For example, claim 35 recites "creating a plurality of program commands for a *particular personalization equipment* using the data fields" and "streaming the plurality of program commands to *the particular personalization equipment* to issue the portable programmable data carrier."
- And, for example, claim 38 recites "wherein the smart card personalization system causes the processing unit to acquire a smart card definition, a card application definition, *program commands for a particular personalization equipment*, and cardholder data."
- And, for example, claim 42 recites "an equipment field containing data representing an *identifier for personalization equipment* used by a personalization system to program the microprocessor identified by the chip field." Furthermore, with respect to claim 42, the previous Office Action admitted that Dethloff does not teach a data structure having such an equipment field.

Claims 26-34, 36-37, 39-41, and 43-44 are dependent on claims 25, 35, 38, and 42, respectively, and are patentable for the reasons argued above.

Because Dethloff does not teach each element in claims 25-44, Applicant's claims cannot be anticipated by Dethloff. Therefore, Applicant respectfully requests the withdrawal of the rejections of claims 25-44 under 35 U.S.C. 102(e) over Dethloff.

Double Patenting Rejection

Claims 25-44 were rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of US Patent No. 5,889,941 and claimed 1-13 of US Patent No. 6,014,748. A terminal disclaimer will be filed to obviate the double patenting rejection after the art rejections under 35 U.S.C. 102(e) are overcome.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-349-9592) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria VA 22313-1450, on this 18 day of June, 2003.

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